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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/528,693

Applicant(s)

WRIGHT ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Acknowledgments

1. The amendment filed May 9, 2003 (Paper No. 11) is acknowledged. The amendment has been entered in part. In accordance with MPEP §714.20 (A), the claim amendments have been entered while the amendment to the specification has *not* been entered.

Restriction

2. This application contains claims 7-20 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Specification

3. The substitute specification filed May 9, 2003 (part of Paper No. 11) has not been entered because it does not conform to 37 CFR 1.125(b) because it does not contain a marked-up copy.¹ Moreover, Applicants have not stated that the substitute proposed specification contains no new matter. Therefore, the previous objections to the specification remain and are repeated below.

¹ See www.uspto.gov/main/newsandnotices.htm for information concerning the status and effect of rule changes regarding claim and specification amendments. Specifically, see e.g. "Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments" and other notices, last accessed July 25, 2003.

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4. Applicants have neither numbered the paragraphs nor the pages in the specification. This makes identification of the specification difficult. The Examiner respectfully recommends numbering either the paragraphs or the pages in the specification.

5. On line 26 of a particular page, a typographical error is present: the "includeany."

Drawings

6. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 14, 2003 (Paper No. 13) have been approved by the Examiner. The corrected or substitute drawings were received on May 9, 2003 (Paper No. 12). These drawings are approved by the Examiner as well.

Claim Rejections - 35 USC § 112 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The claims are replete with errors.

a. In claim 1, it is unclear what specifically is "coupleable to a programmable logic controller" On one hand, it could be the indicator. On the other hand, it could be the predetermined product or even the memory. If "the claims at issue here are not sufficiently

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precise to permit a potential competitor to determine whether or not he is infringing, . . . the claims are invalid for failure to satisfy the “definiteness” requirement of section 112, second paragraph. *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993) (citations omitted). In this case, a potential competitor would not know if its the indicator, the memory, or the predetermined product that is “coupleable to a programmable logic controller.”

b. In claim 1, it remains unclear whether the Applicants are claiming the subcombination of a product information apparatus or the combination of a product information apparatus and the product since Applicants recite said “apparatus comprising: “an indicator . . . associated to said product and contained *in a memory coupled to the predetermined product*. . . . [Emphasis added.]”

If its Applicants intent to claim only the subcombination (product information apparatus only), the body of the claim must be amended to remove any positive recitation of the combination.

Alternatively, if Applicants intend to claim the combination, the preamble of the claims must be amended to be consistent with the language in the body of the claim. By way of example only, the Examiner suggests, “A product information apparatus in combination with a product” As noted below and for prior art purposes², it is the Examiner position that the claims are directed to an apparatus only.

² See MPEP §2173.06

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Applicants can clarify this matter by stating: (a) the claimed product information apparatus does *not* include the predetermined product, or (b) the claimed product information apparatus *includes* the predetermined product).

c. Also in claim 1, it is unclear whether the Applicants are claiming the subcombination of a “product information apparatus” or the combination of a “product information apparatus” and the “network.” By way of example only, Applicants can clarify this matter by stating: (a) the claimed product information apparatus in claims 1-6 does *not* include the network or (b) the claimed product information apparatus *includes* the predetermined product. Applicants may also clarify by e.g. stating that claim 1 includes the network while claims 2-6 do not. Applicants are reminded that it is the Applicants—and not the Examiner—who drafted the claims.

d. In claim 6, it is unclear if “an internet” is the Internet (the one, the only *Internet*) or some other inter-network.

e. In claim 6, it is unclear whether the Applicants are claiming the subcombination of “a product information apparatus” or the combination of “a product information apparatus” and the Internet since Applicants recite “means for automatically interfacing to an internet”

f. Also in claim 6, it is unclear what structural elements make up the “automatically interfacing to the internet to access said web page based on said indicator” “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Medtronic, Inc., v.*

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Advanced Cardiovascular Systems, Inc. 248 F.3d 1303, 1311, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001)(citations and quotations omitted). In other words, “[f]or claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification *must be* presented with sufficient particularity to satisfy the requirements of §112 ¶ 2. [Emphasis added.]” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted).³ In this case, Applicants have again failed to clearly link or associate the means for phrase to some corresponding structure found in specification. Appropriate correction is required.

9. Regarding the combination/subcombination rejections, the Examiner simply asks: Is it the combination or subcombination Applicants intend to claim? Because this issue is frequently misunderstood, the Examiner will briefly attempt to show why this issue is of particular importance.

a. “Claims may not be construed one way in order to obtain their allowance and in a contrary way against infringers.” *Tandon Corp. v. United States Int’l Trade Comm’n*, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). The Examiner recognizes that for literal

³ “Failure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380, 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)). As a quid pro quo for the convenience of employing §112, paragraph 6, Applicant has a clear duty to clearly link or associate structure to the claimed function. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1313 (Fed. Cir. 2000) citing *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997).

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infringement purposes in an apparatus claim, a *subcombination* claim is much more valuable than a combination claim since literal infringement of a subcombination claim can occur at an earlier state of production when compared with a *combination* claim directed to the same subject matter. This is obvious since fewer structural elements are needed for literal infringement in a subcombination claim than would be needed for literal infringement in a corresponding combination claim. (E.g. It would be easier—structurally—to establish literal infringement of a claim directed towards a tire than a claim directed towards a vehicle having the tire.) However, with this lower structural threshold for literal infringement comes a lower structural threshold for anticipation.⁴ And since the Examiner's concern is patentability and not infringement,⁵ the Examiner's concern is *not* with which *type* of claim Applicants choose (i.e. combination or subcombination), but simply that a choice is made. And like any claims, once Applicants' intent (or choice) is known, the claims must comport to their intent.⁶

b. If Applicants intend to claim the subcombination (product information apparatus), logic dictates that only the product information apparatus (and structural elements associated with

⁴ There is a long recognized principle: "that which infringes if later, anticipates if earlier . . ." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 USPQ 561, 574 (Fed. Cir.1986) citing *Peters v. Active Mfg. Co.*, 129 U.S. 530,537 (1889).

⁵ "The business of the PTO is patentability, not infringement." *In re Hogan* 559 F.2d 595, 607, 194 USPQ 527, 538 (CCPA 1977).

⁶ "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. §112, 2nd Paragraph (1994).

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the product information apparatus) may be positively claimed. In this case, any structural elements outside the product information apparatus would be irrelevant since it is physically impossible (by definition) for them to be a part of the claimed product information apparatus.

c. It is the Examiner's factual determination that because claim 1 states "A product information apparatus . . . , said apparatus comprising:" a presumption is established that Applicants intend to claim only the product information apparatus (i.e. the subcombination).

Alternatively, if Applicants intend to claim the combination (e.g. the product information apparatus in combination with the product or in combination with the Internet), Applicants must rebut this presumption. Again, Applicants may rebut this presumption by claiming "A system . . . comprising" *and* expressly indicating in their remarks that they intend to claim the combination. While the scope of this type of claim is less valuable for literal infringement purposes, the quid pro quo for employing this less valuable claim scope is that it usually is more difficult for the Examiner to establish anticipation or obviousness.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1-6, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Cragun et. al. (U.S. 5,804,803)("Cragun '803"). Cragun '803 discloses an indicator (code 117, translation program 110, and URL output; the bar code is a machine readable form of the URL) associated with a product and embedded in a memory (in the magnetic encoded media or radio frequency tag); a web page (document 174) indicated by the indicator (via the URL); the indicator directs the web page to product information (inherent) where the information is provided to the user (via display screen 114); wherein the indicator is specific to each product (tangible object 115) such that a plurality of indicators are needed to find out information about a plurality of products; the indicator (at least the bar code part) is disposed on the label which is on the object (tangible object 115 in Figure 1A); memory (106); means for automatically interfacing with the Internet to access the web page (120 and 121); and the memory is a micro-chip (inherent in radio frequency tag).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Cragun '803 in view of Ohanian et. al. (U.S. 6,109,526) ("Ohanian").⁷ It is the Examiner principle position that the claims are anticipated because of the inherent features (i.e. the old and well known structured and features of RF tags). However if not inherent, Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cragun '803 as taught by Ohanian to include RF tags in replace of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured.

14. Claims 1-6, as understood by the Examiner, are also rejected under 35 U.S.C. 103(a) as being unpatentable over Hudz et. al. (U.S. 5,978,773)("Hudz") in view of Ohanian. Hudz directly or inherently discloses all the claimed features except it uses bar codes instead of memory. Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hudz as taught by Ohanian to include RF tags in replace of bar

⁷ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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codes. Such a modification would have helped get the data more quickly if the bar codes became obscured.

15. Functional recitations using the word “for” (e.g. “for providing said product information” as recited in claim 1) have been given little patentable weight⁸ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

16. As noted in the previous Office Action, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicants’ apparatus claims are clearly “product” or more specifically, “machine” claims.⁹

17. Additional evidence to support the presumption that claims 1-6 are product or machine claims is that claim 5 positively recites memory. “When a computer program is recited in

⁸ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

⁹ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

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conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.” MPEP §2106 IV B. 1 (a) (last paragraph).

18. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,¹⁰ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements.¹¹ Third, after receiving express notice in the previous Office Action¹² of the Examiner’s position that lexicography is *not* invoked, Applicants have not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have not argued lexicography *is* invoked). Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants

¹⁰ See the Examiner’s previous Office Action mailed January 6, 2003, Paper No. 9, Paragraph No. 18.

¹¹ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

¹² See again the Examiner’s previous Office Action, Paper No. 9, Paragraph No. 18.

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have declined the Examiner's express invitation¹³ to be his own lexicographer.¹⁴ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).¹⁵ The Examiner now relies heavily and extensively on this interpretation.¹⁶ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

¹³ *Id.*

¹⁴ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed July 25, 2003).

¹⁵ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification."); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

¹⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability" [Emphasis added.]

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19. The Examiner maintains his interpretations as stated in the previous Office Action. To the extent that the Examiner's interpretations are either different from or in dispute with Applicants' interpretations, the Examiner—under the broadest reasonable interpretation standard noted above and in accordance with *In re Morris*—hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations:

a. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹⁷ **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer:** “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

b. **Controller** “A device on which other devices rely for access to a computer subsystem.” *Id.*

c. **Internet** “The worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. At the heart of the Internet is a backbone of high-speed data communication lines between major nodes or host computers, consisting of

¹⁷ The Examiner finds that the Microsoft Press's *Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.”

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thousands of commercial, government, educational, and other computer systems, that route data and messages.” *Id.*

d. **Network**: “A group of computers and associated network devices that are connected by communications facilities. *Id.*

e. **Programmable logic device** “A logic chip that is programmed by the customer rather than by the manufacturer. . . . *Acronym*: PLD” *Id.* It is the Examiner factual determination that a programmable logic controller is a PLD.

f. **Window** “In applications and graphical interfaces, a portion of the screen that can contain its own document or message.” *Id.*

20. It is the Examiner’s position that as understood by the Examiner, all claimed features in claims 1-6 are either disclosed or inherent in Cragun ‘803 as discussed above. Furthermore, any inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)).

35 U.S.C. 112 6th Paragraph

Means Phrase #1

Invocation

21. It is the Examiner’s position that in claim 6, the phrase “means for automatically interfacing to an internet to access said web page based on said indicator” (“Means Phrase #1”) is

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an attempt by Applicants to invoke 35 U.S.C. 112 6th paragraph. If Applicants disagree, the Examiner respectfully requests Applicants to either amend the claim to remove all instances of “means for” from the claim, or to explicitly state on the record (and supply arguments in support thereof) why 35 U.S.C. 112 6th paragraph should not be invoked.

Invocation Step 1:

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th* (“Guidelines”)¹⁸, and *AI-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),¹⁹ Applicant’s use of “means for” in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6th paragraph. If the word “means” appears in a claim element in combination with a function, it is presumed to be a means-plus-function element in which §112 6th paragraph applies. *Id.* Since “means for” is recited in Means Phrase #1, this step is clearly met.

Invocation - Step 2:

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the

¹⁸ Federal Register Vol 65, No 120, June 21, 2000.

¹⁹ See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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Examiner's position that Applicants recite a corresponding function to the means—"automatically interfacing to an internet to access said web page based on said indicator."

The Examiner notes that when determining the function recited "[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language." *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). In this case, because nothing suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

Invocation - Step 3:

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, "the focus remains on whether the claim ... recites sufficiently definite structure." *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429,

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1436 (Fed. Cir. 1999). Clearly the “automatically interfacing to the internet” can not be entirely performed by the little if any recited structure in the claim.

Because of the above, it is the Examiner’s position that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

Corresponding Structure, Material, or Acts

22. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic*, 248 F.3d at 1311, 58 USPQ2d at 1614, “The next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Id.*

a. In our case and as noted above, the corresponding structure is not clearly linked in the written description with the required specificity. Therefore, a 35 U.S.C. 112 2nd paragraph rejection results. For example, the corresponding structure could be a modem, a DSL network, or some other network connection.

Response to Arguments

23. Applicants’ arguments filed May 9, 2003 (Paper No. 11) have been fully considered but they are not persuasive.

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24. Regarding the objections to the specification, the Examiner again notes that the substitute specification has not been entered (*supra*). Because Applicants have failed to number the pages in the original specification, Applicants' argument that "Support for claim 6 can be found . . . on page 4 of the specification" is not persuasive.

Regarding Applicants' argument that "Support for claim 6 can be found, *inter alia*, in FIG 2" is also not persuasive. This is an objection to the written specification, not the drawings.

25. Regarding the 35 USC § 112 2nd paragraph rejections, Applicants' traversal is acknowledged. Specifically, Applicants argue, "Claim 1 is directed to a 'product information apparatus.' Claim 5 identifies that the 'memory is a micro-chip memory'. Claim 6 identifies how the 'programmable logic controller' is 'coupled to a network.'" These arguments are not persuasive.

26. First, the Examiner understands that "Claim 1 is *directed to* a 'product information apparatus.' [Emphasis added.]" While Applicants' claimed may be *directed to* various objects, it is the objective language of the claims themselves that governs. See *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (*en banc*) (stating that claim language defines claim scope). The Examiner concedes Applicants' *subjective* intent is to *direct* the claims to a "product information apparatus." However, "[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim The focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean." *Biogen, Inc. v. Berlex*

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Laboratories, Inc., 318 F.3d 1132, 1139-40, 65 USPQ2d 1809, 1815 (Fed. Cir. 2003) (citations and quotations omitted). In this case, the Examiner had provided objective evidence (i.e. “contained in a memory *coupled to the predetermined product*”) that claim 1 is construed to include the product. The 35 USC § 112 2nd paragraph therefore remains.

27. Applicants also argue “Cragun does not disclose explicitly or inherently ‘an indicator coupleable to a programmable logic controller.’” The Examiner disagrees. RF tags are clearly “coupleable” to a PLC. The Examiner again notes that Applicants *have not actually claimed* that something is *actually connected* to the PLC—only that it is “coupleable.” When interpreting functional language, if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (Applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference).

28. Finally, Applicants argue “Claim 6 was rejected under 35 USC § 112 2nd and 6th paragraphs.” The Examiner has carefully reviewed the previous office action and can not find any rejection under 35 USC § 112 6th paragraph. The Examiner notes that the heading under which the 35 USC § 112 2nd paragraph rejections were given expressly states: “Claim Rejections - 35 USC § 112 2nd Paragraph.” Because of Applicants’ comment and because that there is no such thing as a rejection under 35 USC § 112 6th paragraph, it is apparent Applicants do not understand the scope and context of claim interpretation in light of 35 USC § 112 6th paragraph.

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The Examiner suggests Applicants see MPEP §2181-2185 and *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

29. Applicants go on to argue that the exemplary language in the specification at page 4 (whichever page is page 4) recites “an internet interface.” Exemplary language is just that—exemplary and indefinite.²⁰ While this is true, determining the corresponding structure of Means Phrase #1 remains indefinite. According to the specification and Applicants’ arguments, it may or may not include a human/machine interface. While 35 USC § 112 6th paragraph is the 4th acceptable method of incorporating the specification or corresponding structure into the claims, (see in *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67, 62 USPQ2d 1658, 1662-63 (Fed. Cir. 2002)), the incorporation must nevertheless be definite. See MPEP 2185.

Conclusion

30. Applicants’ amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

²⁰ See MPEP §2173.05(d).

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Ross et. al. (U.S. 6,550,681 B1); Rhoads (U.S. 6,542,927 B2); Parry (U.S. 6,148,331); Reber et. al. (U.S. 5,986,651); Reber et. al. (U.S. 5,940,595); and Perkowski (U.S. 5,918,214).

32. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from MPEP 8th Edition, August 2001.

33. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular

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rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

34. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because the references are directed towards beginners (see “User Level: Beginning . . .”), the Examiner finds that the references are primarily directed towards those of *low* skill in this art. Because the references are directed towards those of low skill in this art, the Examiner finds that one of *ordinary* skill in this art must—at the very least—be aware of the knowledge and information contained within the references.

35. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (e.g. prior art) and expressly noted their content, this does *not* mean that the other documents of record were not considered and applied when making the prior art rejection(s) above. Moreover, because the

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cannons of claim construction are generally viewed from a person of ordinary skill in the art,²¹ the other documents of record not specifically mentioned in the prior art rejection(s) above were used in the Examiner's deliberative process to assess, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

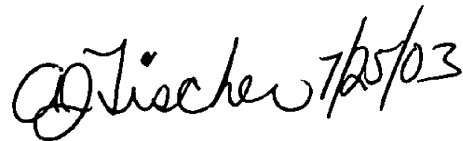
36. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 11 beginning on page 2) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied²², the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in their next properly filed response*. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the

²¹ See e.g. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

²² E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.



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